IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Masaaki KOSAKA *et al.*

Serial No.: 10/069,290

Filing Date: February 25, 2002

For: EXPRESSION ENHANCER FOR HM 1.24 ANTIGEN

Examiner: Jegatheesan Seharaseyon

Group Art Unit: 1647

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Action dated October 6, 2004, applicants elect to prosecute the claims of Group 1, claims 1-8, with *partial* traverse.

Applicants agree with the Examiner that Groups 3 and 4, comprising claims 18-20, may be withdrawn from consideration at this time subject to rejoinder as set forth in paragraphs 10 and 11 of the Action. However, applicants respectfully submit that Groups 2 and 5 should be examined along with Group 1, since those claims, claims 9-17 and 21-28, are drawn to the same or corresponding special technical feature, namely, the enhancement of the expression of HM1.24 antigen using the amino acid sequence of SEQ ID NO: 2.

The Examiner identified the special technical features of Groups 1 and 2 as being the proteins involved in the therapeutic agents claimed. Applicants respectfully submit that this is not a correct application of PCT Rule 13.2 as explained in MPEP 1893.03(d). As explained in that section, "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed

invention, considers as a whole, makes over the prior art." The Examiner's position is based on the citation of prior art allegedly to show that the technical feature of Group 1 identified by the Examiner, interferon-α, is not patentable over the prior art. This analysis is not in accordance with PCT Rule 13.2 or the requirements of the MPEP.

The claims of Groups 1, 2 and 5 are all directed to enhancers, therapeutic agents or activating agents for the HM1.24 antigen having the amino acid sequence as set forth in SEQ ID NO: 2, including an antibody that specifically binds to that protein and has cytotoxic activity. The Examiner has cited no prior art to indicate that this feature, which is common to the claims of Groups 1, 2 and 5 lacks novelty or inventive step over the prior art. Accordingly, these groups of claims should be examined together in accordance with the PCT rules of unity of invention set forth in PCT Rule 13.2. The claims of Groups 3 and 4 are not drawn in the same way and are thus reasonably withdrawn from consideration.

Early action examining claims 1-17 and 21-28 in this application and allowing those claims is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 350292001300.

Respectfully submitted,

Dated: November 8, 2004

By: _____

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